

TTAB



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July 6, 2006

**BY CERTIFIED MAIL**

U.S. Patent and Trademark Office  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

Re: *Kids Need Us Now, LLC v. Kashi Company*: Notice of Opposition

Dear Sir/Madam:

Enclosed for filing please find the original and two (2) copies of Notice of Opposition of Kids Need Us Now, LLC regarding the mark KASHI MIGHTY BITES (Serial No. 78/719203). Also enclosed please find a check in the amount of \$300.00 for the filing fee.

Very truly yours,

Joshua P. Grey

JPG/cnr  
Enclosures

404247

07-10-2006

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of trademark application Serial No. **78/719203**  
For the mark **KASHI MIGHTY BITES**  
Published in the Official Gazette on **May 30, 2006**

Kids Need Us Now, LLC

v.

Kashi Company

NOTICE OF OPPOSITION

Kids Need Us Now, LLC  
354 Merrimack Street  
Lawrence, MA 01843  
State of Organization: Massachusetts

The above-identified opposer believes that it will be damaged by registration of the mark shown in the above-identified application, and hereby opposes the same.

The grounds for opposition are as follows:

FACTS

1. Kids Need Us Now, LLC ("Kids") is a Massachusetts limited liability company with a principal place of business at 354 Merrimack Street, Lawrence, Massachusetts 01843.
2. Kashi Company ("Kashi") is a California corporation with a principal place of business at 4250 Executive Square, Suite 600, La Jolla, California 92037.
3. Kids first used the trademark NATURE'S MIGHTY BITES plus Design, USPTO serial number 78/753922, (the "Kids Design Mark") in or before 2002.
4. Kids first used the Kids Design Mark in commerce throughout the United States in or before 2002.

5. Kids has continuously used the Kids Design Mark in commerce throughout the United States since 2002.
6. Kashi has not claimed use of the trademark KASHI MIGHTY BITES, USPTO serial number 78/719203, (the "Kashi Mark") in commerce.
7. Kashi filed an intent-to-use trademark registration application for the Kashi Mark in the USPTO Principal Register on September 23, 2005 for "processed cereal-derived food product to be used as a breakfast cereal, snack food, or ingredient for making food; ready-to-eat cereal; rolled oats; oatmeal; grain based snack foods; ready-to-eat oat based snack food; oat flakes; processed cereals; frozen waffles" in International Class 30.
8. Kids applied for registration of the Kids Design Mark in the USPTO Principal Register on November 15, 2005, for "Ice cream and ice cream flavor; nutritional bars; fish oil for nutritional purposes; food additives for nutritional purposes" in International Class 30.
9. In an Office Action dated May 20, 2006 (the "May 20, 2006 Office Action"), the USPTO stated, *inter alia*, that "[t]here may be a likelihood of confusion between" the Kids Design Mark and the Kashi Mark; "[t]herefore, . . . action may be suspended pending final disposition of the" Kashi Mark. A copy of the May 20, 2006 Office Action, without attachments, is attached hereto as Exhibit 1.
10. The Kashi Mark was published for opposition in the USPTO Official Gazette on May 30, 2006.
11. Kids received an extension until July 29, 2006, to file an opposition to the registration of the Kashi Mark on the Principal Register.

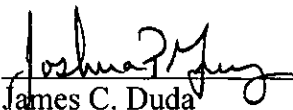
COUNT ONE  
Likelihood of Confusion

12. Kids adopts by reference the allegations contained in paragraphs 1 through 11, above.
13. Kids's use of the Kids Design Mark in commerce predates the first use of the Kashi Mark.
14. The May 20, 2006 Office Action indicated that there was the potential that the Kashi Mark so resembles the Kids Design Mark as may be likely to cause confusion and mistake. Lanham Act § 2(d); *See* Exhibit 1, attached hereto.
15. If there is a likelihood of confusion between the Kids Design Mark and the Kashi Mark, as suggested by the May 20, 2006 Office Action, registration of the Kashi Mark will damage the goodwill Kids has developed with the Kids Design Mark.
16. By reason of the foregoing, the Kashi Mark should be refused registration in International Class 30 on the Principal Register.

WHEREFORE, Kids respectfully demands that the USPTO refuse registration of the Kashi Mark on the Principal Register.

Attorneys for Opposer:

Dated: July 6, 2006

  
James C. Duda  
Joshua P. Grey  
Bulkley, Richardson & Gelinas, LLP  
1500 Main Street, Suite 2700  
Springfield, MA 01115-5507  
Tel: 413-781-2820  
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## **EXHIBIT 1**

Grey, Joshua

**From:** ECom113 [Ecom1133@USPTO.GOV]  
**Posted At:** Saturday, May 20, 2006 6:22 PM  
**Conversation:** TRADEMARK APPLICATION NO. 78753922 - NATURE'S MIGHTY BITES - 25404-1 -  
Message 1 of 3  
**Posted To:** 78753922 - Nature's Mighty Bites design  
**Subject:** TRADEMARK APPLICATION NO. 78753922 - NATURE'S MIGHTY BITES - 25404-1 -  
Message 1 of 3

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 78/753922

**APPLICANT:** Kids Need Us Now, LLC

**CORRESPONDENT ADDRESS:**  
JOSHUA P. GREY  
BULKLEY, RICHARDSON AND GELINAS, LLP  
1500 MAIN ST STE 2700  
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**\*78753922\***

**RETURN ADDRESS:**  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**MARK:** NATURE'S MIGHTY BITES

**CORRESPONDENT'S REFERENCE/DOCKET NO:** 25404-1

**CORRESPONDENT EMAIL ADDRESS:**  
tm@bulkley.com

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number
4. Your telephone number and e-mail address

**OFFICE ACTION**

**RESPONSE TIME LIMIT:** TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE MAILING OR E-MAILING DATE.

**MAILING/E-MAILING DATE INFORMATION:** If the mailing or e-mailing date of this Office action does not appear above, this information can be obtained by visiting the USPTO website at <http://tarr.uspto.gov/>, inserting the application serial number, and viewing the prosecution history for the mailing date of the most recently issued Office communication.

Serial Number 78/753922

The assigned trademark examining attorney has reviewed the referenced application and has determined the following:

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### Section 2(d) - Likelihood of Confusion Refusal

The examining attorney refuses registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), because the applicant's mark, when used on or in connection with the identified goods, so resembles the mark in U.S. Registration Nos. 2754182, 1997772, and 2751210 as to be likely to cause confusion, to cause mistake, or to deceive. TMEP §§1207.01 *et seq.* See the enclosed registrations.

Taking into account the relevant *Du Pont* factors, a likelihood of confusion determination in this case involves a two-part analysis. First, the marks are compared for similarities in appearance, sound, connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Second, the goods or services are compared to determine whether they are similar or related or whether the activities surrounding their marketing are such that confusion as to origin is likely. *In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984); *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re Int'l Tel. and Tel. Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Prods. Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); TMEP §§1207.01 *et seq.*

Applicant has applied to register the mark, NATURE'S MIGHTY BITES (plus design) for "ice cream and ice cream flavor; nutritional bars; fish oil for nutritional purposes; food additives for nutritional purposes."

The registered mark, NATURE'S LITTLE BITES, is for "staple foods, namely, candy and candy bars."

The registered mark, MIGHTY BITE, is for "candy."

The registered mark, NATURE'S MIGHTY 3's is for "nutritional supplements."

It is important to note that the examining attorney must resolve any doubt regarding a likelihood of confusion in favor of the prior registrant(s). *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir., 1988). TMEP §§1207.01(d)(i).

### Comparison of the Marks

The examining attorney must compare the marks for similarities in sound, appearance, meaning or connotation. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Similarity in any one of these elements is sufficient to find a likelihood of confusion. *In re Mack*, 197 USPQ 755 (TTAB 1977). TMEP §§1207.01(b) *et seq.*

As per the registered mark, NATURE'S LITTLE BITES, the overall commercial impression is confusingly similar to applicant's mark, NATURE'S MIGHTY BITES as they first and last words of the marks are identical. The difference between LITTLE and MIGHTY signifies a mere variation in size of the goods, i.e. that the particular good is either smaller or larger in size. A consumer encountering the marks at issue would likely confuse the marks as emanating from the same source, but merely varying sizes of the goods at issue. Moreover, the Trademark Trial and Appeal Board has held that the first word, prefix, or syllable in a mark is typically the dominant portion. *Presto Products v. Nice-Pak Products, Inc.*, (9 USPQ2d 1895 (TTAB 1988)). "[I]t is often the first part of a mark which is most likely to be impressed upon the mind or a purchaser and remembered when making purchasing decisions involving the services of the applicant and registrant." *Id.* at 1897. Here, both the first and last word of the marks at issue are dominant.

With regard to the registered mark, MIGHTY BITE, two of the terms of applicant's mark, NATURE'S

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MIGHTY BITES are identical or nearly identical. Applicant has merely added the term "NATURE'S" to the terms MIGHTY BITE. That applicant has added an "S" to the end of BITE to form the plural version as little to no impact on the overall commercial impression of the marks at issue. It is important to note that the mere addition of a term to a registered mark does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Section 2(d). *In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) ("GASPAR'S ALE and "JOSE GASPAR GOLD"); *Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (C.C.P.A. 1975) ("BENGAL" and "BENGAL LANCER"); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (C.C.P.A. 1967) ("THE LILLY" and "LILLI ANN"); *In re El Torito Rests. Inc.*, 9 USPQ2d 2002 (TTAB 1988) ("MACHO" and "MACHO COMBOS"); *In re United States Shoe Corp.*, 229 USPQ 707 (TTAB 1985) ("CAREER IMAGE" and "CREST CAREER IMAGES"); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) ("CONFIRM" and "CONFIRMCELLS"); *In re Riddle*, 225 USPQ 630 (TTAB 1985) ("ACCUTUNE" and "RICHARD PETTY'S ACCU TUNE"); *In re Cosvetic Laboratories, Inc.*, 202 USPQ 842 (TTAB 1979) ("HEAD START" and "HEAD START COSVETIC"); TMEP §1207.01(b)(iii). Thus, the addition of the term "NATURE'S" to the registered mark does not overcome a likelihood of confusion in this case.

As discussed above, the Trademark Trial and Appeal Board has held that the first word, prefix, or syllable in a mark is typically the dominant portion. *Presto Products v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895 (TTAB 1988). "[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered when making purchasing decisions involving the services of the applicant and registrant." *Id.* at 1897. Accordingly, when the first two terms of a mark are identical, a likelihood of confusion is great. It follows that confusion is highly likely between the registered mark, NATURE'S MIGHTY 3's, and applicant's mark, NATURE'S MIGHTY BITES.

Additionally, it is essential to note that when a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods or services. Therefore, the word portion is normally accorded greater weight in determining likelihood of confusion. *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729 (TTAB 1976); TMEP §1207.01(c)(ii). Accordingly, the design portion of applicant's mark is not significant in terms of a Section 2(d) analysis, nor is it sufficient to overcome a likelihood of confusion between the literal element of applicant's marks, and the registered marks.

#### Comparison of the Goods

The goods of the parties need not be identical or directly competitive to find a likelihood of confusion. Instead, they need only be related in some manner, or the conditions surrounding their marketing be such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Prods. Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re Int'l Tel. & Tel. Corp.*, 197 USPQ 910 (TTAB 1978); TMEP §1207.01(a)(i). Here, the goods at issue are all foods or food additives.

Attached are copies of printouts from the USPTO X-Search database, which show third-party registrations of marks used in connection with the same or similar goods as those of applicant and registrant in this case. These printouts have probative value to the extent that they serve to suggest that the goods listed therein, namely ice cream, food additives, and meal replacement bars (i.e., nutritional

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bars) and candy or candy bars, are of a kind that may emanate from a single source. *See In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-1218 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 at n.6 (TTAB 1988).

The goods at issue between the registered mark, NATURE'S MIGHTY 3's and applicant's mark are both food or nutritional supplements. Registrant's goods are nutritional supplements, which would include or be highly related to nutritional bars, fish oil for nutritional purposes, and food additives for nutritional purposes. The intended purpose of the goods at issue is to supply nutrients that are missing in a person's diet. Naturally such goods travel in the same channels of trade and would and consumers would encounter the goods under the same or similar circumstances. (See attached internet evidence.)

Because the overall commercial impression of the marks at issue are confusingly similar, and because multiple component parts of the marks at issue are identical or nearly identical, and because the goods at issue are highly related food or food related goods that are of a kind that may emanate from a single source, registration is refused under Section 2(d) of the Trademark Act.

Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration.

Applicant must note the following additional refusals.

**Mark Does Not Function As A Trademark; Improper Specimen of Use for Goods- Class 30 goods**

The Examining Attorney refuses registration because the proposed mark does not function as a trademark. Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051, 1052 and 1127. The proposed mark neither identifies and distinguishes the goods of the applicant from those of others nor indicates their source. *In Re Remington Products Inc.*, 3 USPQ2d 1714 (TTAB 1987). TMEP §§1202 *et seq.* Please note that the proposed mark does not function as a trademark because the specimen submitted with the application is unacceptable as evidence of actual trademark use; therefore, the proposed mark cannot identify and distinguish the applicant's goods from those of others nor indicate their source.

The specimen is unacceptable as evidence of actual trademark use because it is merely on-line advertising for the product. Invoices, announcements, order forms, bills of lading, leaflets, brochures, publicity releases and other advertising material generally are not acceptable specimens. *In re Bright of America, Inc.*, 205 USPQ 63 (TTAB 1979); TMEP §§904.05 and 904.07. *See In re Ultraflight Inc.*, 221 USPQ 903 (TTAB 1984).

Accordingly, the applicant must submit a specimen showing the mark as it is used in commerce. 37 C.F.R. § 2.56. Examples of acceptable specimens are tags, labels, containers, and photographs that show the mark on the goods or packaging. TMEP §§904.04 *et seq.* The applicant must verify, with an affidavit or a declaration under 37 C.F.R. §2.20, that the substitute specimen was in use in commerce prior to the filing of the application. 37 C.F.R. §2.59(a); TMEP § 904.09.

If an amendment of the dates-of-use clause is necessary in order to state the correct dates of first use, the applicant must verify the amendment with an affidavit or a declaration in accordance with 37 C.F.R. §2.20. 37 C.F.R. §2.71(c); TMEP §903.05.

The following is a properly worded declaration under 37 C.F.R. §2.20. Applicant should add the following declaration paragraph to the end of its response, and include a dated signature by a person authorized under 37 C.F.R. §2.33(a). 37 C.F.R. §2.20.

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*The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that the substitute specimen was in use in commerce prior to the filing of the application; that the facts set forth in this application are true; all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.*

\_\_\_\_\_  
(Signature)

\_\_\_\_\_  
(Print or Type Name and Position)

\_\_\_\_\_  
(Date)

Pending an adequate response to the above, the examining attorney refuses registration under Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051, 1052 and 1127, because the record does not show use of the proposed mark as a trademark.

#### OPTION – AMENDMENT TO BASIS

The applicant may overcome this particular refusal to register this mark by amending the application to assert a different basis for filing the application and submitting the requirements for the new basis. TMEP §§806.03 *et seq.* In this case, applicant may wish to amend the application to assert a Section 1 (b) basis.

If the applicant amends its basis, the applicant must also provide a signed verification or signed declaration attesting that applicant had a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application as of the application filing date. 37 C.F.R. §§2.34(a)(2)(i), (a)(3)(i) and (a)(4)(ii); TMEP §§804.02, 806.01(b), 806.01(c), 806.01(d) and 1101.

The following declaration is provided for the applicant's convenience:

*The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. §1051(b), 1126(d) or 1126(e), he/she believes applicant to be entitled to use such mark in commerce; that the applicant had a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application as of the application filing date; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.*

\_\_\_\_\_  
(Signature)

\_\_\_\_\_  
(Print or Type Name and Position)

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(Date) \_\_\_\_\_

**Drawing and Specimen Do Not Match- Class 5 Goods**

The mark as depicted on the drawing does not agree with the mark as it appears on the specimen, and clarification is required. 37 C.F.R. §2.51; TMEP §§807.12 and 807.12(a). In the present case, the drawing displays the mark as NATURE'S MIGHTY BITES with a brown and tan themed drawing, and the specimen shows the mark as NATURE'S MIGHTY 3 with a green themed drawing. Applicant may not submit an amended drawing to conform to the display on the specimen because the character of the mark would be materially altered, i.e., the mark on the specimens creates a different commercial impression from the mark on the drawing. 37 C.F.R. §2.72(a); TMEP §§807.12, 807.12(a), 807.14 *et seq* and 904.09.

Therefore, applicant must do one of the following:

- (1) submit a substitute specimen showing use of the mark as it appears on the drawing, with a statement that "the substitute specimen was in use in commerce at least as early as the filing date of the application," verified with an affidavit or a signed declaration under 37 C.F.R. §2.20; 37 C.F.R. §§2.59(a) and 2.72(a); TMEP §904.09; or
- (2) amend the basis to Section 1(b) and satisfy all the requirements for this new basis. TMEP §806.03(c).

Although the trademark examining attorney has refused registration, applicant may respond to the refusals to register by submitting evidence and arguments in support of registration.

If the applicant chooses to respond to the refusals to register, the applicant must also respond to the following requirements.

**Identification and Classification of Goods**

The wording "ice cream flavor" in the identification of goods needs clarification because it is indefinite and could include goods in multiple classes. Applicant may change this wording to "ice cream flavor in the nature of flavoring syrups for ice cream," in Class 30, if accurate. TMEP §1402.01.

The wording "nutritional bars" in the identification of goods needs clarification because the goods could be classified in multiple classes depending upon the composition of the bar. Applicant may change this wording to "protein based, nutrient-dense snack bars," in Class 29, if accurate. TMEP §1402.01.

The wording "fish oil for nutritional purposes" in the identification of goods needs clarification because it is indefinite and appears to be misclassified. The particular nature and use of the oil must be specified. Applicant may change this wording to "dietary food supplements in the nature of fish oil," in Class 5, if accurate. TMEP §1402.01.

The wording "food additives for nutritional purposes" in the identification of goods needs clarification because the type of additive is not identified. Applicant may change this wording to "nutritional additives for use in foods," in Class 5, if accurate. TMEP §1402.01.

**Applicant may amend to one or more of the following, if accurate:**

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Class 5: dietary food supplements in the nature of fish oil; nutritional additives for use in foods

Class 29: protein based, nutrient-dense snack bars

Class 30: ice cream; ice cream flavor in the nature of flavoring syrups for ice cream

Please note that while an application may be amended to clarify or limit the identification, additions to the identification are not permitted. 37 C.F.R. §2.71(a); TMEP §1402.06. Therefore, the applicant may not amend to include any goods or services that are not within the scope of the goods and services recited in the present identification.

For assistance with identifying goods and/or services in trademark applications, please see the online searchable *Manual of Acceptable Identifications of Goods and Services* at <http://less2.uspto.gov/netahtml/tidm.html>.

Use of the online identification manual is strongly encouraged when framing an appropriate response to this Office Action.

### **Combined Applications**

If applicant prosecutes this application as a combined, or multiple-class application, then applicant must comply with each of the requirements below for those goods and/or services based on actual use in commerce under Trademark Act Section 1(a):

- (1) Applicant must list the goods/services by international class with the classes listed in ascending numerical order;
- (2) Applicant must submit a filing fee for each international class of goods and/or services not covered by the fee already paid (current fee information should be confirmed at <http://www.uspto.gov>); and
- (3) For each additional class of goods and/or services, applicant must submit:
  - (a) dates of first use of the mark anywhere and dates of first use of the mark in commerce, or a statement that the dates of use in the initial application apply to that class; the dates of use, both anywhere and in commerce, must be at least as early as the filing date of the application;
  - (b) one specimen showing use of the mark for each class of goods and/or services; the specimen must have been in use in commerce at least as early as the filing date of the application;
  - (c) a statement that "the specimen was in use in commerce on or in connection with the goods and/or services listed in the application at least as early as the filing date of the application;" and
  - (d) verification of the statements in 3(a) and 3(c) in an affidavit or a signed declaration under 37 C.F.R. §2.20. (NOTE: Verification is *not* required where (1) the dates of use for the added class are stated to be the same as the dates of use specified in the initial application, or (2) the original specimens are acceptable for the added class.)

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37 C.F.R. §§2.6, 2.34(a), 2.59, 2.71(c), and 2.86(a); TMEP §§810, 904.09, 1403.01 and 1403.02(c).

**Disclaimer**

Applicant must disclaim the descriptive wording "BITES" apart from the mark as shown because it merely describes a feature of applicant's goods, namely, that they are bite sized. Trademark Act Section 6, 15 U.S.C. §1056; TMEP §§1213 and 1213.03(a). See attached definition. Attached are also representative registrations from the Patent and Trademark Office registration database, which evidence the descriptiveness of the wording "BITES," via disclaimers.

The computerized printing format for the Office's *Trademark Official Gazette* requires a standardized format for a disclaimer. TMEP §1213.08(a)(i). The following is the standard format used by the Office:

No claim is made to the exclusive right to use "BITES" apart from the mark as shown.

See *In re Owatonna Tool Co.*, 231 USPQ 493 (Comm'r Pats. 1983).

**Complete Color Claim and Color Location Statements Required**

Although applicant attempted to comply with the requirement for a color claim and color location statement, the information provided is not sufficiently precise. Applicant must submit the following color claim and color description:

- (1) a statement that "the color(s) black, white, brown, tan, and light tan are claimed as a feature of the mark;" and
- (2) a separate description of where the colors appear in the mark, i.e., "the color black appears in the lettering NATURE'S MIGHTY BITES, in the outline of the cloud, tree, and ground designs appearing in the mark, as well as in the outline of the main design element which features a bite mark design in the bottom right hand corner. The color white appears in the cloud designs. The color brown appears in the human figure on the left and in the patches of grass and dirt on the ground, as well as in the trunks of the trees. The color tan appears in the middle human figure, the sin and the middle strip of land appearing in the design, as well as in the outline of the terms MIGHTY BITES. The color light tan appears in the human figure on the right hand side of the design." 37 C.F.R. §2.52(b)(1); TMEP §807.07 *et seq.*

Common color names should be used to describe the colors in the mark, e.g., red, yellow, blue. TMEP §807.07(a)(ii).

**Claim of Prior Pending Application Will Not Be Printed- Advisory**

Applicant's claim of ownership of Application Serial No. 78735774 will not be printed on any registration that may issue from this application because only claims of ownership of pertinent live registrations are printed. If the claimed pending application registers before this application, then applicant may claim ownership of it by registration number. 37 C.F.R. §2.36; TMEP §812.

**Name(s) of Member(s) of LLC Will Not Be Printed- Advisory**

The individual names of the owners, members, or corporate officers of the limited liability company should not be listed on the application because a limited liability company is like a corporation, which is identified only by its corporate name. The individual names provided on the application will not appear on any certificate which may issue. TMEP §803.03(h)

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### **Prior Pending Applications**

Information regarding pending Application Serial Nos. 78719203 and 78722928 are enclosed. The filing dates of the referenced applications precede applicant's filing date. There may be a likelihood of confusion between one or both of the marks under Trademark Act Section 2(d), 15 U.S.C. §1052(d). If one or both of the referenced application registers, registration may be refused in this case under Section 2(d). 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon entry of a response to this Office action, action on this case may be suspended pending final disposition of the earlier-filed applications.

If applicant believes there is no potential conflict between this application and the earlier-filed applications, then applicant may present arguments relevant to the issue in a response to this Office action. The election not to submit arguments at this time in no way limits applicant's right to address this issue at a later point.

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### **HOW TO RESPOND TO THIS OFFICE ACTION:**

- **ONLINE RESPONSE:** You may respond using the Office's Trademark Electronic Application System (TEAS) Response to Office action form available on our website at <http://www.uspto.gov/teas/index.html>. If the Office action issued via e-mail, you must wait 72 hours after receipt of the Office action to respond via TEAS. **NOTE: Do not respond by e-mail. THE USPTO WILL NOT ACCEPT AN E-MAILED RESPONSE.**
- **REGULAR MAIL RESPONSE:** To respond by regular mail, your response should be sent to the mailing return address above, and include the serial number, law office number, and examining attorney's name. **NOTE: The filing date of the response will be the date of receipt in the Office,** not the postmarked date. To ensure your response is timely, use a certificate of mailing. 37 C.F.R. §2.197.

**STATUS OF APPLICATION:** To check the status of your application, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov>.

**VIEW APPLICATION DOCUMENTS ONLINE:** Documents in the electronic file for pending applications can be viewed and downloaded online at <http://portal.uspto.gov/external/portal/tgw>.

**GENERAL TRADEMARK INFORMATION:** For general information about trademarks, please visit the Office's website at <http://www.uspto.gov/main/trademarks.htm>

**FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY SPECIFIED ABOVE.**

7/5/2006